UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,368	12/19/2000	Douglas G. Murray	END9-2000-0164US1	2367

			EXAMINER
23550	7590	05/06/2004	TRIEU, LAURENT L

HOFFMAN WARNICK & D'ALESSANDRO, LLC
3 E-COMM SQUARE
ALBANY, NY 12207

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2000*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☒ Claim(s) *31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-36 have been examined.

Specification

2. The disclosure is objected to because of the following informalities: Paragraph 0036 discloses "Then, the hardware information would be transmitted 70 to log 60" whereas Figure 2 shows "Display Notice 60" and "Log Hardware Info. 70" connecting to "Remove Verif. App./File 72". Appropriate correction is required.

3. Claim 31 is objected to because of the following informalities: Limitation 1 states "...wherein the verification file include a ...". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12, 14, 15, 17, 18, 20-22, 24, 25, 31-33, 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Park, US Patent Number US 6, 260, 141 B1.

Regarding claim 12 – Park meets the claimed limitations as follows:

o Providing a processor – "a user's computer" (Column 3, line 16)

o   Installing a verification application on the processor – "the user's license control

program checks the license file" (Column 3, lines 17-18)

o   Locating a verification file with the verification application, wherein the verification file

includes at least one processor identification and at least one product identification –

    "The user receives an updated license file which now includes the purchased

software product information in addition to CPU information" (Column 4, lines 62-64).

o   Comparing the at least one verification file processor identification with a

corresponding processor identification stored on the processor – "The license file is

dependent on a specific CPU" (Column 4, lines 4-5)

Regarding claim 14 – "specific CPU" (Column 4, line 5), wherein to acknowledge a

'specific CPU' requires an identifier for the CPU.

Regarding claim 15 – "attempted usage of a software product will result in the software

product asking the user's software license control program on a user's computer whether

the user has a usage license for the software product" (Column 3, lines 15-18) where

usage reads using the installation program of the product.

Regarding claim 17 – "the user's license control program checks the license file, received

from a software registration server" (Column 3, lines 17-19).

Regarding claim 18 – "a CPU based license file is encrypted by the CPU public key"
(Column 4, 21-22)

Regarding claim 20 – Park meets the claimed limitations as follows:

o   An access system for accessing a verification file, wherein the verification file includes

    a hardware identification and a product identification – "The user receives an updated

    license file which now includes the purchased software product information in addition

    to CPU information" (Column 4, lines 61-65)

o   A comparison system for comparing the hardware identification of the verification file

    with a corresponding hardware identification on a computer hardware component –

    "The license file is dependent on a specific CPU" (Column 4, lines 4-5)

o   A registry system for registering license information in a registry – "The user receives

    an updated license file" (Column 4, line 61-62)

o   A log system for logging hardware information in a log – "The method may include

    storing user information, CPU information and software product usage license

    information in a software registration server database" (Column 2, lines 9-11)

Regarding claim 21 – "attempted usage of a software product will result in the software

product asking the user's software license control program on a user's computer whether

the user has a usage license for the software product" (Column 3, lines 15-18) where

'usage' reads on using the installation program of the product.

Regarding claim 22 – "CPU information" (Column 2, line 9) reads on hardware

component being a processor and hardware information being a processor identification.

Regarding claim 24 – "the user's license control program checks the license file, received

from a software registration server" (Column 3, lines 17-19)

Regarding claim 25 – "Normally, the license file is encrypted by user public key" (Column

4, line 20)

Regarding claim 31 – Park meets the claimed limitations as follows:

o   An access system for accessing a verification file, wherein the verification file include

    a hardware identification and a product identification – "The method may include

    storing user information, CPU information and software product usage license

    information in a software registration server database" (Column 2, lines 9-11)

o   A comparison system for comparing the hardware identification of the verification file

    with a corresponding hardware identification on a computer hardware component –

    "The receives an updated license file which now includes the purchased software

    product information in addition to CPU information" (Column 4, lines 61-64)

o   A registry system for registering license information in a registry – "The method may

    include storing user information, CPU information and software product usage license

    information in a software registration server database" (Column 2, lines 9-11)

o   A log system for logging hardware information in a log – "The method may include

    storing user information, CPU information and software product usage license

    information in a software registration server database" (Column 2, lines 9-11)

Regarding claim 32 – "attempted usage of a software product will result in the software

product asking the user's software license control program on a user's computer whether

the user has a usage license for the software product" (Column 3, lines 14-18)

Regarding claim 33 –"the user registers his CPU once per CPU" (Column 3, lines 42)

Regarding claim 35 – "the user's license control program checks the license file, received

from a software registration server" (Column 3, lines 17-19)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-5, 7, 8, 10, 19, 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Park in view of LeBOURGEOIS, WO 98/420098.

Regarding claims 1 and 19 – While Park teaches a software license control that meets

closely the claimed limitations as follows:

    o   Providing a computer hardware component – "a user's computer" (Column 3, line

       16)

Park does not explicitly address the plurality concept of the product and hardware

identifications as explicitly done by LeBOURGEOIS.

    o   Accessing a verification file, wherein the verification file includes a plurality of

       product identifications and hardware identifications with a corresponding hardware

       identification stored on the hardware component – Park teaches that "The

       software product information is added to the license file every time a new product

       is purchased or a product is upgraded" (Park, Column 3, lines 59-61) where the

       addition of the information to the license file comprises a compilation (i.e. plurality)

       of product identifications "every time a new product is purchased".

In addition, LeBOURGEOIS discloses, "In one embodiment, the reader system

generates the reader system signature in dependence upon component signatures

from the following components, to the extent present in the system. [Hardware list

follows] (Page 23, lines 10+)

- Comparing the plurality of hardware identifications with a corresponding hardware identification stored on the hardware component – LeBOURGEOIS discloses, "In an embodiment, the reader system signature is determined by examining various components (hardware and/or software) of the reader system to determine individual signatures for each component" (Page 6, lines 31-34). It would have been obvious for one of ordinary skill in the art at the time of invention to modify Park's invention to include a plurality of "product and hardware identifications" in the license verification file. The motivation would have been to allow "a certain amount of 'upgrade drift' before it is deemed advisable to check for unauthorized use" (Page 6, lines 29-30).

Regarding claim 2 – Park discloses, "The user receives an updated license file" (Column 4, lines 61-62) where receiving a file reads on writing license information in registry of hardware component.

Regarding claims 3 and 4 – "The CPU is registered to the software registration server" (Column 4, line 55).

Regarding claim 5 – "Normally, the license file is encrypted" (Column 4, line 20)

Regarding claim 7 – "hardware or central processing unit (CPU)" (Column 3, line 38)

Regarding claim 8 – "the user's license control program checks the license file" (Column 3, lines 17-18)

Regarding claim 10 – "the user's license control program checks the license file, received from a software registration server" (Column 3, lines 17-19)

Regarding claim 26 – While Park meets the claimed limitations as follows:

o   An access system for accessing the verification file – "On a user's computer, a software product asks the user software license control program whether the user has a usage license for the software product" (Abstract)

o   A comparison system for comparing the verification file hardware identifications with a corresponding hardware identification stored on the hardware component, and for comparing the verification file product identifications with a corresponding product identification of a product being installed on the hardware component – "attempted usage of a software product will result in the software product asking the user's software license control program on a user's computer whether the user has a usage license for the software product" (Column 3, lines 15-18).

Park does not explicitly address the plurality concept of the product and hardware identifications as explicitly done by LeBOURGEOIS.

o   A verification file having a plurality of hardware identifications and product identifications – Park teaches that "The software product information is added to the license file every time a new product is purchased or a product is upgraded" (Park,

Column 3, lines 59-61) where the addition of the information to the license file

comprises a compilation (i.e. plurality) of product identifications "every time a new

product is purchased".

In addition, LeBOURGEOIS discloses, "In an embodiment, the reader system signature

is determined by examining various components (hardware and/or software) of the

reader system to determine individual signatures for each component" (Page 6, lines 31-

34). It would have been obvious for one of ordinary skill in the art at the time of invention

to modify Park's invention to include a plurality of "product and hardware identifications"

in the license verification file. The motivation would have been to allow "a certain amount

of 'upgrade drift' before it is deemed advisable to check for unauthorized use" (Page 6,

lines 29-30).

Regarding claim 28 – wherein the log is on a server – "The method may include storing

user information, CPU information and software product usage license information in a

software registration server database" (Column 2, lines 9-11)

Regarding claim 30 – "the user's license control program checks the license file, received

from a software registration server" (Column 3, lines 17-19)

6. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Park in view of Pettit, US Patent No. 5,864,620.

Regarding claims 6 and 15, — While Park discloses, "Once registration is complete, attempted usage...If the answer is 'yes', the software product continues" (Column 3, lines 22-23) – where usage reads on 'installing a program', Pettit further teaches that, "The user 18 then uses the authorization certificate and the master key to unlock the software container 20 and install the software in step 84." (Column 5, lines 56-58). It would have been obvious for one of ordinary skill in the art at the time of invention to control the usage in Park's invention to even include the installation process. The motivation would have been to maintain control of the content from right from the installation stage.

7. Claims 9, 11, 13, 16, 23, 27, 29, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park.

Regarding claim 9 – removing the verification application, after the comparison step – Examiner takes Official Notice that applications are removed from processors once they are no longer needed. It would have been obvious for one of ordinary skill in the art to enable Park's invention to remove the application from the system once it is no longer needed to allow other applications to execute. The motivation would have been de-allocate the unused process/space for other applications to execute.

Regarding claims 11, 16, 23, 29 and 34 – wherein the accessing step comprises accessing an encrypted verification file from a drive associated with the hardware component – Though Park teaches receiving a verification file from a server, it does not

mention receiving it through a network drive. Examiner takes Official Notice that using the 'map network drive' feature in Microsoft Windows (TM) 95, it would have been obvious to one of ordinary skill in the art at the time of invention to remotely connect to a shared folder where the verification file is stored and retrieve said file. The motivation would to do so would have been to enable for another means of receiving files (possibly for automated scripts) as an alternate to downloading such file via a web browser.

Regarding claim 13 –

o Writing license information in a registry of the processor – "The user receives an updated license file ... This new license file replaces the old license file" (Column 4, lines 61-65)

o Logging processor information in a log – "The CPU is registered to the software registration server" (Column 4, line 55)

o Removing the verification application from the processor – Examiner takes Official Notice that applications are removed from processors once they are no longer needed. It would have been obvious for one of ordinary skill in the art to enable Park's invention to remove the application from the system once it is no longer needed. The motivation would have been de-allocate the unused process/space for other applications to execute.

Regarding claims 27 and 36 – While Park discloses:

○   A log system for logging hardware information in a log - "The method may include

storing user information, CPU information and software product usage license

information in a software registration server database" (Column 2, lines 9-11)

○   A registry system for registering license information in a registry of the hardware

component – "The user receives an updated license file ... This new license file

replaces the old license file" (Column 4, lines 61-65)

○   A decryption system for decrypting the verification file – While Park discloses, "the

license file is encrypted" (Column 4, line 20), "The user receives an updated license

file" (Column 4, lines 61-62) and "the software product asking the user's software

license control program on a user's computer whether the user has a usage license

for the software product" (Column 3, lines 15-17); it does not explicitly state that the

decryption of the verification file. Examiner takes Official Notice that there is a

decryption step between the user receiving the verification file and the software

product asking for verification.   It would have been obvious to one of ordinary skill in

the art to use Park's invention in decrypting an encrypted verification file. The

motivation would have been to properly use an encrypted file by first decrypting it

prior to using its content.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These art include: Pearce et al. U.S. Patent 6, 243, 468 B1, Bains et al, U.S. Patent 5,579,222, Hamadi et al., U.S. Patent 5,742,757 and Davis 5, 568, 552.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurent L Trieu whose telephone number is 703-305-0712. The examiner can normally be reached on Monday - Friday 8AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laurent L. Trieu
Art Unit 2137
27 April 2004.

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100